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In re Patent No. 6,872,211 :
Issued: March 29, 2005 :
Application No. 10/057,535 : DECISION REGARDING PTA
Filed: January 24, 2002 :
Atty. Dkt. No.: BSC-159C1 :

OFFICE OF PETITIONS

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)," filed May 26, 2005.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Patent No. 6,872,211 on March 29, 2005. The instant request for reconsideration was timely filed May 26, 2005. Patentees argue that the above-identified patent was improperly accorded a Patent Term Adjustment (PTA) of 85 days when instead the patent was entitled to an adjustment of 167 days. Patentees further argue that the .82 day reduction in connection with the submission of a miscellaneous letter on January 7, 2005 was not a failure to engage in reasonable efforts to conclude prosecution or processing within the meaning of 37 CFR 1.704.

A review of the application history reveals that an adjustment of 196 days was accorded in accordance with 37 CFR 1.702(a)(1) for failure to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date the application was filed. The adjustment began March 25, 2003, the day after the date that is 14 months after the date that the application was filed, and ended October 6, 2003, the date the non-final Office action was mailed.

The adjustment of 196 days was reduced 29 days in accordance with 37 CFR 1.704(b) for applicants' failure to respond within three months of the mail date of the non-final Office action. The reduction began January 7, 2003, the day after the date that is three months after the date the non-final Office action was mailed, and ended February 4, 2004, the date a response was filed.

The adjustment of 196 days was further reduced 82 days in accordance with 37 CFR 1.704(c)(10) due to submission of a miscellaneous letter, namely, a notice of assignee name change, on January 7, 2005. The adjustment began January 7, 2005, the date of submission of the miscellaneous letter, and ended March 29, 2005, the date of issuance of the patent.


As previously noted, applicants argue that the submission of the notice of assignee name change is not a failure to engage in reasonable efforts to conclude prosecution because the notice of assignee name change "does not require a response or any action from the PTO, and therefore did not cause substantial interference and delay in the patent issue process."

Applicants' arguments have been considered and found unconvincing. The period of adjustment of the term of a patent under 37 CFR 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. See, 37 C.F.R. § 1.704(a). Submission of a paper after the Notice of Allowance has been mailed constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application. See, 37 C.F.R. § 1.704(c)(10) and 1247 Off. Gaz. Pat. Off. 111 (June 26, 2001). Current Office policy holds that submission of a notice of assignee name change after Notice of Allowance has been given and prior to issuance of a patent does both interfere with and delay the patent issue process and, therefore, deemed a failure to engage in reasonable efforts to conclude prosecution/processing.

The Office acknowledges receipt of the required \$200.00 application fee submitted herewith.

Patentees are given one (1) month to request reconsideration of this decision. The period of time for reconsideration is not extendible under 73 CFR 1.136(a) or 37 CFR 1.136(b).

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3202.


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